Remarks/Arguments:

Claims 5-9, previously presented, with claim 5 amended, hereby, are pending. By the instant Amendment the end of claim 5 is amended to read "the heat insulation body being non-cracked as manufactured by dry-compressing."

Claims 5 and 6 remain rejected under 35 USC 103(a) based on the combined teachings of Kratel and Takahashi, and claims 7-9 remain rejected under 35 USC 103(a) based on the combined teachings of Kratel, Takahashi and Sklarski. Reconsideration is requested.

That the *non-cracked* property of the invention is not recited in the rejected claims is of no moment, notwithstanding allegations to the contrary in the statement of rejection; "being manufactured by dry-compressing" as recited in the rejected claims necessarily results in the claimed product possessing the *non-cracked* property. Therefore, the *non-cracked* property must be taken into consideration when comparing the claims against the prior art, even though it is not recited in the rejected claims. *In re Estes*, 164 USPQ 519 (CCPA).

Notwithstanding the foregoing, in order to advance prosecution the claims are amended, hereby, to "the heat insulation body being non-cracked as manufactured by dry-compressing." The "non-cracked" feature, now *expressly recited* in the claims, is a limitation on the present claims not supported in the cited prior art. Since "the cited references do not support each limitation of [the] claim[s]," the rejection rejection is "inadequate on its face." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim

against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). A "ground of When conducting an obviousness analysis, "all limitations of a claim must be considered in determining the claimed subject matter as is referred to in 35 U.S.C. 103 and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982).

Moreover, the fact that the product in the rejected claims is defined using product-by process language does not mean that the *process* limitation cannot patententably distinguish the prior art, as alleged in the statement of rejection. It is "incongruous" to find "different processes each inherently produce identical products." *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Lack of patentability "of invention set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result in the practice of processes disclosed in references." 220 USPQ at 314.

In view of the showing, the rejections are in order for withdrawal. Therefore, withdrawal of the rejections under section 103(a) is in order.

Furthermore, as previously explained on the record, the rejection is not supported by evidence or scientific reasoning to support the allegation that *wet-processing* in accordance with the prior art is essentially identical to "dry-processing" in accordance with the present claims. Since it has not been shown that both reactants and reaction conditions of wet-processing, as disclosed in the prior art, are essentially identical to "dry-processing," as presently claimed, the PTO has failed to establish the prima facie case necessary to shift the burden to applicants to provide rebuttal evidence. *In re Spada*, 15 USPQ2d 1655 (Fed. Cir. 1990)

According to the Office Action, the claims are not commensurate in scope with the scope of the Rule 132 declaration of co-inventor Octavian Anton ("the first Anton Declaration"). Accordingly, submitted herewith is another Rule 132 Declaration by Mr. Anton ("the second Anton Declaration") (the submitted Declaration is unexecuted – the executed version will be submitted as soon as received by the undersigned). The second Anton Declaration contains the examples found in the first Anton Declaration and two further examples – Examples 2 and 3 – and comparative examples – Examples 2a and 3a. Example 2 includes small amounts of xonotlite and large amounts of pyrogenic silica (finely divided metal oxide). Example 3 includes large amounts of xonolite and small amounts of pyrogenic silica (finely divided metal oxide). Examples 2a and 3a represent the corresponding comparative examples prepared by a wet process. As can be seen from figures 4 and 5 in the second Anton Declaration, the examples prepared by the wet process are poorly shaped. They evidence drying shrinkage and cannot be used unless they are sanded or cut to get a regularly shaped product.

The second Anton Declaration also corrects an inadvertent error found in the first Anton Declaration. In the first Anton Declaration one example (with 10% xonolite) is prepared by dry pressing and was compared with a wet mixture. The resulting products are shown in Fig. 1, but in Fig. 2 only the comparative example (showing cracks) is magnified. The legend of figure 2 is, therefore, incorrect. There is no sample "formed by dry pressing (left side)" in Fig. 2, only the sample formed by "wet pressing." The error is regretted.

Furthermore, the second Anton Declaration includes a better printout of Fig. 3 than used in the first Anton Declaration. In Fig. 3, a low lambda value corresponds to good insulating properties.

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Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By _____
William E. Player
Reg. No. 31,409

400 Seventh Street, NW
The Jenifer Building
Washington, D.C. 20004
Tel. (202) 638-6666
Fax (202) 393-5350
Date: July 20, 2004
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